



WITSCHEL et al., Serial No. 09/763,704

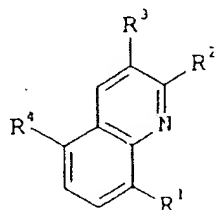
### REMARKS

In response to the examiner's communication of October 24, 2001, applicants respectfully submit that their intention was to supply the examiner with the provisionally elected species at the earliest time possible. Though an indication was made that such a reply might possibly be made as early as October 15, 2001, applicants do not recall specifically stating that they would *certainly* have a species elected by that time. Further, the October 22 date was understood to be the date for mailing, and not for actually having the election in the hands of the examiner. The reply was, in fact, prepared on this day, when the required information was received, and was mailed on the 23rd of October. Applicants regret any misunderstanding and inconvenience they may have caused.

Applicants respectfully request the examiner's reconsideration of the restriction requirements made, based on the following discussion of PCT Rule 13. According to this rule, a PCT-based application "shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention')" (Rule 13.1). This unity of invention is "fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features" (Rule 13.2). Such "'special technical features' [are those] that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art" (Rule 13.2). Further, the rule permits inclusion of "a reasonable number of dependent claims ... even where the features of any dependent claim could be construed as constituting in themselves an invention" (Rule

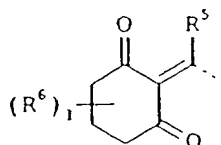
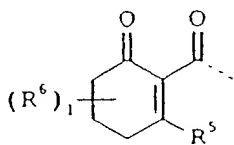
13.4).

In the present application, the common technical feature that defines the contribution of these species collectively over the prior art is the common core depicted on page 1 of the specification as formula I. This formula is depicted here:



The specification says that the "herbicidal properties of the prior art compounds and their compatibility with crop plants are not entirely satisfactory," and that "provid[ing] other ... herbicidally, active compounds ... is achieved by the cyclohexenonequinolinoyl derivatives of the formula I and their herbicidal action" (specification p.6:34-43).

At the  $R^4$  moiety of formula I, either of formulae IIa or IIb can be attached:



Which one is attached determines the naming of the species as Ia or Ib. The common special technical feature of formula I remains intact in either case. To these formulae Ia and Ib, various substituents can be added at the point labeled  $R^6$ , and depending on the substituent added, the species is then identified as Ia1 (or Ib1), Ia2 (or Ib2), etc., up to Ia8 (or Ib8) (see specification at p.50,61-64). Each of these groupings *also* contain the special technical feature of formula I, which defines the *entire set* of species over the prior art.

Within these groups, the substituents R<sup>1-3</sup> and R<sup>5</sup> are differentially substituted to obtain the final species, which are identified as Ia1.1 (or Ib1.1) through Ia1.456 (or Ib1.456), 2.1 through 2.66 (based on Ia6), and 3.1 through 3.6 (based on Ib6). *Each* of these species contains the special technical feature - formula I - which defines *the entire invention* over the prior art. Accordingly, each of the species contains the precise "core" molecule identified by formula I. The fact that this supports a finding of unity of invention can be inferred by the international phase of prosecution, in which such unity was not questioned. Applicants provisionally elect species 1a6.129, which is compound 2.17 of the specification, described on page 77, in table 2. The restriction requirement, is, of course, traversed as indicated above.

Applicants further note that the examiner has not actually given *any reasoning* behind the finding on unity of invention. To suggest that unity is lacking because "[t]he species lack a common core," without any further discussion, does not seem to indicate a thorough analysis using PCT Rule 13. Applicants understand the examiner's burden to require an explanation in which the unique special technical feature of each group (i.e., each individual species, in this case) is specifically described, and then discussed *vis a vis* that possessed by each of the other groups (see, e.g. MPEP §1893.03(d)). This has not been met in the present case, and applicants respectfully submit that such a showing would not be possible. Each individual species in the present application contains the base formula I, which has been shown to be a special technical feature defining the entire set of species over the prior art. Applicants respectfully request the examiner to kindly withdraw the restriction requirement and to proceed to examine the

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entire application as required by PCT Rule 13.

Applicants additionally solicit passage of the application to issue.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,  
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'David C. Liechty', with a long horizontal flourish extending to the right.

David C. Liechty  
Reg. No. 48,692

1101 Connecticut Ave., N.W.  
Washington, D.C. 20036  
(202)659-0100  
DCL/mks

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